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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,329	09/18/2000	Ronni S. Sterns	CRT/11842	3765

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EXAMINER

FERNSTROM, KURT

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 04/04/2003

11

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APPLICATION NO/ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

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See attached Answer to the Appeal Brief



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 11

Application Number: 09/663,329

Filing Date: 9/18/00

Appellant(s): Ronni S. Sterns, et al

Wayne D. Porter Jr.

For Appellant

Art Unit: 3712

EXAMINER'S ANSWER

This is in response to the appeal brief filed on January 23, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

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(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-4, 6-8, 10, 13-16 and 18-19 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

3,081,560	CAMPO AGUD	3-1963
6,024,571	RENEGAR	2-2000
4,478,582	TUCKER	10-1984
5,224,610	VEAZEY	7-1993
3,154,870	HOPP	11-1964
5704147	RELLINGER	1-1998
6,139,331	OWEN	10-2000

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4, 6-8, 10, 13-16 and 18-19 are rejected under 35 U.S.C. 103. This rejection is set forth in prior Office Action, Paper No. 8.

(11) *Response to Argument*

With respect to the argument that the claimed invention is distinct from the cited prior art because it is intended for use in allowing a person who speaks a first language to vocally

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communicate with a second person who speaks a second language, as presented for example on page 8 and on page 10 of the brief, the intended use of an apparatus may not serve as the basis of patentability, under MPEP 2114. As long as the structure of the claimed apparatus is disclosed or suggested by the prior art, viewed as a whole, rejection of the claims is proper. Furthermore, the claims recite a display "to enable a person who speaks a first language to communicate vocally with a second person who speaks a second language." Even if this language describing the intended purpose of the invention were to be given patentable weight, the prior art including Campo Agud and Renegar reads on this limitation. The three reasons given on page 8 of the brief as to why Campo Agud could not be used in the manner of the claimed invention are not pertinent because the intended use of an apparatus does not have patentable weight. In particular with respect to reason (1), which asserts that Campo Agud discloses "only parts of sentences", Campo Agud discloses source phrases and target phrases, which reads precisely on the claim language of the present invention. Nowhere do the claims recite that each card comprises an entire sentence.

Campo Agud and Renegar disclose devices for teaching a foreign language. Such teaching enables a person who speaks a first language to communicate vocally with a second person who speaks a second language. Renegar in particular relates to vocal communication, as it discloses in Figures 2 and 4 phonetic transliterations of a phrase directly below that phrase. With respect to claim 6, Campo Agud discloses in Figure 1 that its board is C-shaped, allowing for storage of the cards as shown in Figure 2. Because Campo Agud and Renegar are both drawn to the same art, of devices for teaching foreign languages, the combination of the two is proper.

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Tucker discloses a device for teaching various aspects of language, including grammar and syntax. As such, it is in an art analogous to that of Campo Agud and Renegar, in that all three are directed to teaching language. Tucker discloses a plurality of display cards for displaying words, where different background colors are provided for different parts of speech. Thus, it is drawn to the same problem as the background colors of the claimed invention, and its teachings of providing different background colors for the purpose of clearly identifying different parts of speech are properly combined with the teachings of Campo Agud and Renegar.

With regard to the arguments concerning Hopp and Rellinger, both Hopp and Rellinger are directed to display boards. While neither is directed to a phonetic transliteration card display, both are precisely drawn to the exact problems contemplated by applicant; the respective problems of allowing a user to join a plurality of boards together for a larger display of words and allowing the user to easily removably attach cards representing words to a display board. Because both Hopp and Rellinger are drawn to the precise problems contemplated by applicant, and both are in an analogous art of display boards for displaying words, the combination of both references with Campo Agud and Renegar is proper.

The combination of Owen with Campo Agud is proper for similar reasons. Owen is in the analogous art of display boards, and is drawn to the same problem as applicant of providing a display board with storage space behind the display. Also, contrary to appellant's assertion, the flanges of Campo Agud as shown in Figure 1 are capable of use for storing the cards, firstly because storing and displaying are not mutually exclusive activities and secondly because the cards are capable of being stored in the channels of the Campo Agud board when all or part of the

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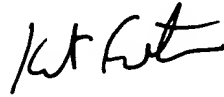
device is not in use. Because Owen is drawn to the same problem as that contemplated by applicant, and is in an analogous art of display boards, the combination of Owen with Campo Agud is proper.

The combination of Veazey with Campo Agud and Owen is also proper. Veazey discloses a display board having end caps for aesthetic purposes and for the purpose of protecting the sides of the board. While the motivation provided by Veazey to add end caps to a display board is not precisely identical to the motivation contemplated by appellant, the test for whether references may be combined is not whether the proposed motivation is exactly identical to that contemplated by the applicant. Because Veazey is in an analogous art of display boards, and discloses the structure and the motivation of having end caps on a display board, the combination of Veazey with the other cited prior art proper.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Kurt Fernstrom

KF

December 6, 2001

Conferees



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